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RFC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Concurrent Technologies Corp.**

Serial No. 75/538,498

Mark J. Young of Draughon Professional Association for
Concurrent Technologies Corp.

Gerald T. Glynn, Trademark Examining Attorney, Law Office
102 (Thomas Shaw, Managing Attorney).

Before **Cissel**, Holtzman and Drost, Administrative Trademark
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On August 18, 1998, applicant filed the above-
referenced application to register the mark "VIRTUALCAST"
for "computer software for simulating metal forming
processes," in Class 9. The application was based on
applicant's assertion that it possessed a bona fide intent
to use the mark in commerce in connection with these goods.

The Examining Attorney refused registration under
Section 2(e)(1) the Lanham Act, 15 U.S.C. 1052(e)(1), on

the ground that the mark sought to be registered is merely descriptive of the goods identified in the application. He contended that the mark "merely describes the virtual reality feature of this specialized software which allows simulating metal casting operations." In support of the refusal to register, he submitted copies of two third-party registrations of marks for computer software on the Principal Register wherein the word "virtual" has been disclaimed, and one third-party registration on the Principal Register with a disclaimer of the word "cast." The goods in that registration include metal castings.

Applicant responded to the refusal to register by amending the identification of goods in the application to "computer software for simulating metal forming processes, namely, comprehensive mold filling and solidification simulation, with advanced user interfaces allowing users to define specific properties, store information and utilize visualization tools," in Class 9. Applicant argued that the mark is not merely descriptive of these goods, which are software which "has nothing whatsoever to do with virtual reality." Thus, argued applicant, "the term 'virtual' as used in applicant's mark is a suggestive term, not a descriptive one." Citing thirty-one dictionary definitions of the word "cast," including "to form into a

particular shape by pouring into a mold," applicant argued that because the word "cast" has so many meanings, it does not describe applicant's goods with any degree of particularity. Based on this, applicant took the position that its mark is suggestive, rather than descriptive, as applied to its goods.

The Examining Attorney was not persuaded by applicant's arguments, however, and in the second Office Action, he made final the refusal to register under Section 2(e)(1). Submitted with the final refusal was an excerpt from a published article about the "Cast Metal Coalition," a group of metal-casting technical societies which promotes research and development in that industry. Also submitted was an excerpt from a computer glossary wherein the term "virtual" is defined as "an adjective applied to almost anything today that expresses a condition without boundaries or constraints." In the same glossary, the term "casting" is defined as a term used in programming to designate "the conversion of one data type into another." Also attached were copies of three other third-party registrations. Two of these registrations are on the Principal Register with disclaimers of the word "virtual." The third mark also includes the word "virtual," but that registration is on the Supplemental Register.

Applicant timely filed a notice of appeal, which was accompanied by a request for reconsideration.

The request for reconsideration argued that when properly considered as a unitary composite mark, "VIRTUALCAST" is suggestive, rather than merely descriptive, of the goods identified in the application. Applicant further argued that even if the mark is broken down into its component terms, it is nonetheless only suggestive in connection with these goods. Applicant submitted copies of thirty-two third-party registrations for marks which incorporate the word "virtual" without any disclaimer or claim of acquired distinctiveness, and fifty-three third-party registrations for marks wherein "virtual" is the sole undisclaimed component of marks with two or more components. Applicant argued that this evidence establishes the past practice in the Patent and Trademark Office of registering on the Principal Register marks combining "virtual" with descriptive terminology.

The Examining Attorney considered applicant's arguments and evidence, but maintained the refusal to register. Submitted with the Office Action maintaining the refusal were excerpts apparently retrieved from an automated database. Although several show the term "virtual cast" in the context of unrelated fields such as

orthopedic medicine, fossils or paleontology, two clearly relate to metal forming processes involving molds. One states that "VCF computer model (Virtual Casting Furnace) has been used to optimize the casting conditions. A variety of material quality criteria are determined by computer simulation. Based on the simulations, a concept for an online process control is presented. The goal of this concept is to develop strategies that minimize deviations from the optimal process control by the use of computer simulation during the casting process." The second apparently comes from a paper presented in 1996 to a conference of photovoltaic specialists. The title of the paper appears to be "Virtual casting - a dream come true or an expensive nightmare?" The abstract of the text is as follows: "In this modern high technology age of virtual reality 'desk top' or 'virtual' casting has become the dream of the foundry engineer... This article attempts to give an objective view of the application of casting simulation software and highlights the positive aspects and the pitfalls."

The Examining Attorney argued that these excerpts show that "virtual casting" is a term used to identify computer simulated metal forming processing such as casting molten metal into molds, and that in view of this fact, the term

applicant seeks to register, "VIRTUALCAST," if used in connection with "computer software for simulating metal forming processes, namely, comprehensive mold filling and solidification simulation," would immediately and forthwith convey significant information about the goods, i.e., that the purpose or function of the software is computer simulation of the casting process.

Both applicant and the Examining Attorney filed appeal briefs, and applicant requested an oral hearing before the Board. Some confusion arose regarding the scheduling of the hearing, however, and applicant did not appear for the scheduled hearing on October 12, 2000. Applicant subsequently withdrew its request for a hearing, choosing to rely on its brief.

The sole issue before the Board in this appeal is whether the mark "VIRTUALCAST" is merely descriptive within the meaning of Section 2(e)(1) of the Act in connection with the computer software for simulating metal forming processes identified in the application. We find that it is, so the refusal to register on this basis is well taken.

A term is considered to be merely descriptive of goods within the meaning of section 2(e)(1) Trademark Act if it immediately and forthwith conveys information concerning a significant quality, characteristic, feature, function,

purpose or use of the goods. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215 (CCPA 1978). It is not necessary that a term describe all of the properties or functions of the goods in order for it to be considered merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or feature of them. Moreover, whether a term is merely descriptive is determined not in the abstract, but rather in relation to the goods for which registration is sought, the context in which it is or will be used on or in connection with those goods, and the possible significance that the term would have to the average purchaser of the goods because of the manner of its use. In re Bright-Crest Ltd., 204 USPQ 591 (TTAB 1979). Whether consumers could guess what the product is from consideration of the mark alone is not the test. In re American Greetings Corp., 226 USPQ 635 (TTAB 1985). That particular words have other meanings in other contexts is irrelevant. The issue is whether purchasers of the particular goods in question would understand the mark to convey information about a significant aspect of such products.

On the other hand, a mark is only suggestive, and hence registrable, if, when the goods bearing the mark are encountered, a multi-stage reasoning process, or the

utilization of imagination, thought or perception, is required in order to determine what attributes of the goods the mark conveys. See: Abcor Development Corp., supra, at 218, and In re Mayer-Beaton Corp., 223 USPQ 1347, 1349 (TTAB 1984). As has often been stated, there is a thin line of demarcation between a suggestive mark and a merely descriptive one, with the determination of which category a mark falls into frequently being a difficult matter involving a good measure of subjective judgment. In re Atavio, 25 USPQ2d 1361 (TTAB 1992) and In re TMS Corp. of the Americas, 200 USPQ 57 (TTAB 1978).

In the instant case, the term sought to be registered is merely descriptive of the goods with which applicant intends to use it because if prospective purchasers of applicant's software for simulating metal forming processes were to encounter the mark "VIRTUALCAST" in connection with these goods, they would immediately understand the mark to identify the purpose or function of the goods, namely, that applicant's software enables users to conduct virtual casting, i.e., computer simulation of the casting process, in order to obtain the best results.

This case is very similar to the one recently decided by this Board in In re Styleclick.com Inc., ___ USPQ2d ___ (TTAB 2001). In that case, the mark "VIRTUAL FASHION" was

held to be merely descriptive of "computer software for consumer use in shopping via the global computer network featuring apparel, fashion, accessories, personal care items, jewelry and cosmetics." Judicial notice was taken of dictionary definitions of the term "virtual" as follows: "not physical. Exists in software only or the imagination of the machine." Net.speak-the internet dictionary (1994); "used generally to describe something without a physical presence or is not what it appears to be. Virtual reality, for example, is made up of computer-generated images and sounds rather than actual objects." The Computing Dictionary (1996); and "conceptual rather than actual, but possessing the essential characteristics of a real function." The Illustrated Dictionary of Microcomputers (3rd ed. 1990). When these meanings of "virtual" were considered in light of the meaning of "fashion" in connection with the recited services in that case, we found that the use of "VIRTUAL FASHION" in connection with that applicant's services would immediately describe, without conjecture or speculation, a significant feature or characteristic of the services, namely that they involve, inter alia, using a computer to shop for fashions in a virtual sense, i.e., with the enhancements offered by virtual reality.

When the same meanings are attributed to the term "virtual" in the instant case, and those connotations are combined with the plain descriptive meaning of the word "cast" in connection with metal casting¹, it is clear that the mark "VIRTUALCAST" identifies the purpose or use of applicant's software, which applicant admits provides computer simulation of this metal forming process.

We have reviewed all the third-party registrations made of record by both applicant and the Examining Attorney. Just as in the "VIRTUAL FASHION" case, supra, such third-party registrations are of little help in determining the merits of this appeal. As we stated in our opinion in that case, while uniform treatment under the Lanham Act is an administrative goal, the task of this Board is to determine, based on the record before us, whether applicant's mark is merely descriptive. Each case must be decided on its own merits. We are not privy to the records in the files of the cited registrations, but in any event, the determination of the registrability of one particular mark by an Examining Attorney is not determinative in a case before the Board involving another,

¹ "Casting" is merely another way of identifying the process described in the application as the metal forming process of "comprehensive mold filling and solidification."

different mark for different products or services. In re Nett Designs, Inc., 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001). While it appears that the Office may not have been consistent with respect to the registrability of marks similar to applicant's mark, our language and the commercial use of it is always changing, and our job is to try to resolve appeals based on contemporary common usage of words. When we do this in the case at hand, we must conclude that "virtual," in the context of applicant's mark, has a generally recognized meaning with respect to computers and software. When this non-source-identifying prefix is coupled with the descriptive word "cast" in applicant's mark, the combination, "VIRTUALCAST," considered in its entirety, is merely descriptive of the computer software identified in the application.

The fact that applicant has combined these two descriptive words without leaving a space between them does not alter the descriptive significance of the combination of them, nor does the fact that applicant may be the first or the only entity using this combination in connection with such software render the term any less descriptive. In re Central Sprinkler Co., 49 USPQ2d 1194 (TTAB 1998).

As computer technology continues to evolve, descriptive terms incorporating the word "virtual" are

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certain to multiply. Such terms must remain available for competitors to use in connection with their own products.

Decision: The refusal to register under Section 2(e)(1) is affirmed.

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